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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* JEFFREY BRADY, KEVIN MCMURTRY,
9 and GREG MILLER
10

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12 Appeal 2009-004339
13 Application 10/440,521
14 Technology Center 3600
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17 Decided: September 23, 2009
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20 Before HUBERT C. LORIN, ANTON W. FETTING, and
21 BIBHU R. MOHANTY, *Administrative Patent Judges*.
22 FETTING, *Administrative Patent Judge*.

23 DECISION ON APPEAL
24

1 STATEMENT OF THE CASE

2 Jeffrey Brady, Kevin McMurtry, and Greg Miller (Appellants) seek
3 review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-6, 53-
4 56, and 61, the only claims pending in the application on appeal.

5 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
6 (2002).

7 SUMMARY OF DECISION¹

8 We REVERSE.

9 THE INVENTION

10 The Appellants invented a system and method for generating and
11 planning events, meetings, or related series of meetings (Specification 1:9-
12 11).

13 An understanding of the invention can be derived from a reading of
14 exemplary claim 61, which is reproduced below [bracketed matter and some
15 paragraphs added].

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed January 30, 2008) and Reply Brief ("Reply Br.," filed July 15, 2008), and the Examiner's Answer ("Ans.," mailed May 16, 2008), and Final Rejection ("Final Rej.," mailed May 29, 2007).

1 61. An apparatus for planning at least one assigned-time event
2 correspondent to a request of a non-attendee meeting requester,
3 comprising:

4 [1] a database storing a plurality of event parameter sets
5 including at least recruiting, venue and speaker meeting
6 parameters and an assigned time associated with the at least one
7 assigned-time event plan, wherein at least some event
8 parameters of the event parameter sets have associated business
9 rules restricting planner selection of others of the event
10 parameters of the event parameter sets in combination with the
11 business rule associated event parameters;

12 [2] an event logistics module presenting ones of the event
13 parameters for selection by a planner distinct from the non-
14 attendee meeting requestor based on a request from the
15 nonattendee meeting requestor, wherein the presentation of the
16 event parameters from each of the plurality of event parameter
17 sets in the database by the logistics module to the planner is
18 restricted by:

19 [a] planner selection of at least one other presented
20 event parameter from the plurality of event parameter
21 sets in the database; and

22 [b] at least one of the business rules responsively to
23 planner selection of a business rule associated event
24 parameter from the plurality of event parameter sets in
25 the database; and

26 [3] a reporting module, wherein information associated with
27 the assigned-time event plan, in accordance with said assigned
28 time and at least one selected event parameter, is provided to
29 the non-attendee meeting requestor.

1 THE REJECTIONS

2 The Examiner relies upon the following prior art:

Bingham et al. US 6,324,517 B1 Nov. 27, 2001

3 Claims 1-6, 53-56, and 61 stand rejected under 35 U.S.C. §103(a) as
4 being unpatentable over Bingham.

5 ARGUMENTS

6 *Claims 1-6, 53-56, and 61 rejected under 35 U.S.C. §103(a) as being*
7 *unpatentable over Bingham*

8 The Appellants argue these claims as a group.

9 Accordingly, we select claim 61 as representative of the group. 37
10 C.F.R. § 41.37(c)(1)(vii) (2008).

11 The Examiner found that Bingham described all of the limitations of
12 claim 61, except Bingham fails to describe that the meeting requester is
13 distinct from a meeting planner (Ans. 3-9). The Examiner found that a job
14 title or job function of an individual is merely non-functional descriptive
15 material and therefore is not given patentable weight (Ans. 7). The
16 Examiner further took Official Notice of the fact that it is old and well-
17 known in the art for an individual or company to request help from a third-
18 party to conduct the details of planning an event (Ans. 7-8). The Examiner
19 found that a person with ordinary skill in the art would have recognized that
20 benefit of standardizing practice by outsourcing planning tasks to a third-
21 party event planner (Ans. 8). The Examiner further found that a person with

1 ordinary skill in the art would have found it obvious to modify Bingham
2 with this old and well-known feature (Ans. 8).

3 The Appellants contend that (1) Bingham fails to describe that the
4 presentation of at least one event parameter to an event planner is restricted
5 by the selection of another event parameter, as required by limitation [2a]
6 (App. Br. 13 and 16-17 and Reply Br. 4-5), (2) Bingham fails to describe
7 that the presentation of at least one event parameter to an event planner is
8 restricted by at least one business rule responsively to the selection of an
9 event parameter associated to the business rule in addition to the selection of
10 at least one other event parameter presented, as required by limitation [2b]
11 (App. Br. 13 and 18-21 and Reply Br. 4-5), (3) the Examiner erred in
12 rejecting claims 1 and 53 for the same reasons argued *supra* (App. Br. 21-22
13 and Reply Br. 5-8), and (4) there is no motivation or reason to modify
14 Bingham absent impermissible hindsight, as per claim 53 (App. Br. 23-24
15 and Reply Br. 8-11).

16 ISSUES

17 The pertinent issue to this appeal is whether the Appellants have
18 sustained their burden of showing that the Examiner erred in rejecting claim
19 1-6, 53-56, and 61 under 35 U.S.C. § 103(a) as unpatentable over Bingham.
20 The pertinent issue turns on whether Bingham describes restricting the
21 selection or presentation of an event parameter based on the selection of
22 another event parameter or a business rule associated with a selected
23 parameter.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

01. The planning system includes a set of specific instructions that are applicable to particular events or event type (Specification 63:1-2). These instructions, or business rules, can be accepted or rejected by the user of the system (Specification 63:13-16).

Facts Related to the Prior Art

Bingham

02. Bingham is directed to a method and system for selecting facilities for holding meetings, conferences, conventions, trade shows, special events, and other group-related events (Bingham 1:23-27).

03. The method includes the steps of receiving a request for a meeting facility where the request defines the minimum requirements for the facility, calculating an all-inclusive cost for the facility, ranking a list of facilities based on the all-inclusive cost, and transmitting a list of a subset of the facilities to a user (Bingham 2:59-67).

04. A user can further request the presentation of a list of amenities that the user can further narrow the subset of available facilities (Bingham 9:56-62).

05. The list of facilities can be sorted based on various criteria, such as cost, location, amenities, and quality (Bingham 10:41-56).

Facts Related To The Level Of Skill In The Art

06. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of event planning and scheduling. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

07. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1363-64 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d

1 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
2 specification” without importing limitations from the specification into the
3 claims unnecessarily).

4 Although a patent applicant is entitled to be his or her own
5 lexicographer of patent claim terms, in *ex parte* prosecution it must be
6 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant
7 must do so by placing such definitions in the specification with sufficient
8 clarity to provide a person of ordinary skill in the art with clear and precise
9 notice of the meaning that is to be construed. *See also In re Paulsen*, 30
10 F.3d 1475, 1480 (Fed. Cir. 1994) (Although an inventor is indeed free to
11 define the specific terms used to describe his or her invention, this must be
12 done with reasonable clarity, deliberateness, and precision. “Where an
13 inventor chooses to be his own lexicographer and to give terms uncommon
14 meanings, he must set out his uncommon definition in some manner within
15 the patent disclosure” so as to give one of ordinary skill in the art notice of
16 the change. *See Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1387-
17 88, 21 USPQ2d 1383, 1386 (Fed.Cir.1992).)

18 *Obviousness*

19 A claimed invention is unpatentable if, “the differences between the
20 subject matter sought to be patented and the prior art are such that the
21 subject matter as a whole would have been obvious at the time the invention
22 was made to a person having ordinary skill in the art.” *KSR Int’l Co. v.*
23 *Teleflex Inc.*, 550 U.S. 398, 399 and 406 (2007); *Graham v. John Deere Co.*,
24 383 U.S. 1, 13-14 (1966).

25 In *Graham*, the Court held that that the obviousness analysis is
26 bottomed on several basic factual inquiries: “[1)] the scope and content of

1 the prior art are to be determined; [(2)] differences between the prior art and
2 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
3 in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550
4 U.S. at 406. “The combination of familiar elements according to known
5 methods is likely to be obvious when it does no more than yield predictable
6 results.” *KSR*, 550 U.S. at 416.

7 ANALYSIS

8 *Claims 1-6, 53-56, and 61 rejected under 35 U.S.C. §103(a) as being*
9 *unpatentable over Bingham*

10 The Appellants first contend that (1) Bingham fails to describe that the
11 presentation of at least one event parameter to an event planner is restricted
12 by the selection of another event parameter, as required by limitation [2a]
13 (App. Br. 13 and 16-17 and Reply Br. 4-5) and (2) Bingham fails to describe
14 that the presentation of at least one event parameter to an event planner is
15 restricted by at least one business rule responsively to the selection of an
16 event parameter associated to the business rule in addition to the selection of
17 at least one other event parameter presented, as required by limitation [2b]
18 (App. Br. 13 and 18-21 and Reply Br. 4-5).

19 We agree with the Appellants. The Appellants specifically contend that
20 the Examiner has misconstrued the term business rule (App. Br. 19) and as
21 such we must determine whether the construction of this term is proper.

22 First we look to the claims for the context of the term and any limitations
23 imposed by it. Limitation [1] requires that business rules are associated with
24 event parameters and the business rules restrict the selection of other
25 parameters. Limitation [2] further requires that the event parameters

1 presented to a user for selection are restricted by the selection of another
2 event parameter and a business rule associated with a selected event
3 parameter. That is, the available event parameters presented to a user are
4 determined based the user's selection of another event parameter and
5 whether that selected parameter has a business rule associated to it.

6 Next we look to the Specification for any definition of the term and its
7 usage to also give insight to the context of its use. The Specification is silent
8 as to a specific definition for business rule. The Specification uses the
9 context of a business rule as a set of specific instructions applied to the
10 planning of particular events of event types (FF 01).

11 The Examiner and the Appellants agree that the plain meaning of the
12 term business rule is a statement that defines some aspect of business or how
13 the business operates (App. Br. 13 and Ans. 11). The Examiner applies this
14 definition to claim 61 and constructs a business rule to require nothing more
15 than the mere input of meeting preferences and minimum requirements
16 (Ans. 11). The Examiner found that Bingham describes the input and
17 selection of a meeting or event parameters and therefore describes restricting
18 the presentation of a parameter based on a business rule associated to a
19 selected parameter (Ans. 11).

20 However this would instead be a rule about the process of managing a
21 database rather than a rule restricting planner selection of others of the event
22 parameters of the event parameter sets in combination with the business rule
23 associated event parameters. It might allow entry of the rules as claimed,
24 but would not itself be such a rule. Also, this construction renders a
25 business rule to be synonymous with a set of meeting requirements or the
26 definition of a single meeting. This is not compatible or consistent with the

1 Specification. The Specification and claims consistently use the term
2 business rule as an expression that governs aspects of a particular *type* of
3 meeting and is more than just a collection of meeting parameters that define
4 a single meeting. The Examiner is not making any distinction between the
5 definition of a single meeting, versus a definition that controls a *type* of
6 meeting. In particular, a business rule governs the process of a specific *type*
7 of meeting being defined and we construe a business rule to be an expression
8 that defines the availability of meeting parameters for a particular *type* of
9 meeting.

10 Bingham describes a method where a user defines the parameters of a
11 meeting and the system returns a list of facilities and an all-inclusive cost
12 associated with each facility (FF 03). Bingham enables a user to narrow the
13 list of facilities based on required amenity parameters (FF 04) and further
14 allows a user to sort the list based on an event parameter (FF 05). However,
15 Bingham fail to explicitly describe restricting the selection or presentation of
16 event parameters based on other selected parameters or business rules
17 associated those selected parameters. Bingham fails to describe restricting
18 the selection or presentation of a parameter based on an expression that
19 controls the available parameters for a particular type of meeting. Bingham
20 is silent on any feature that describes restricting the selection or presentation
21 of any parameter. As such, Bingham fails to describe limitations [1] and [2]
22 of claim 61.

23 The Appellants also contend that (3) the Examiner erred in rejecting
24 claims 1 and 53 for the same reasons argued *supra* (App. Br. 21-22 and
25 Reply Br. 5-8). We agree with the Appellants. The Appellants' arguments
26 were found to be sufficient *supra* and are found to be sufficient here for the

1 same reasons. As such, Bingham fails to describe the limitations of claims 1
2 and 53.

3 Although the Appellants further contend that (4) there is no motivation
4 or reason to modify Bingham absent impermissible hindsight, as per claim
5 53 (App. Br. 23-24 and Reply Br. 8-11), we need not reach this argument
6 since the Appellants' arguments *supra* were found to be dispositive.

7 CONCLUSIONS OF LAW

8 The Appellants have sustained their burden of showing that the
9 Examiner erred in rejecting claims 1-6, 53-56, and 61 under 35 U.S.C. §
10 103(a) as unpatentable over Bingham.

11 DECISION

12 To summarize, our decision is as follows.

- 13 • The rejection of claims 1-6, 53-56, and 61 under 35 U.S.C. § 103(a) as
14 unpatentable over Bingham is not sustained.

16 REVERSED

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18
19
20 mev

21
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